

R E M A R K S

1. Statement of Substance of the Interview

Applicants' representative thanks the Examiner for the courtesy of granting an Interview on February 25, 2011. During the Interview, Applicants representative asked the Examiner if amending the claims to recite polyunsaturated fatty acids (PUFAs) having 20-24 and two to six double bonds would be sufficient to overcome the rejection under 35 U.S.C. § 112. The Examiner questioned whether a claim which recited a number of double bonds in a PUFA, without reciting their precise location in the PUFA, is sufficiently definite to satisfy 35 U.S.C. § 112. The Examiner indicated that he would consider such an amendment in light of the accompanying remarks. However, the Examiner agreed that such an amendment should render the claims definite enough to perform a prior art search.

Applicants' representative also inquired whether amending the claims to recite, e.g., "a transesterified composition" instead of a "oil/fat or triglyceride" would overcome the rejection under 35 U.S.C. § 112. The Examiner indicated that such an amendment should overcome the rejection under 35 U.S.C. § 112. The present amendment and response is entirely consistent with the Interview.

2. Status of the Claims

Applicants request reconsideration in light of the above amendment and following comments. The claims are amended without disclaimer of any subject matter and without prejudice to Applicants' rights to present any canceled subject matter in this or a continuing application.

Claims canceled: Claims 10, 17-20, and 24-26

Claims pending: Claims 1-9, 11-16, 21-23, and 27-30

Claims allowed: None

Claims rejected: Claims 11-13 and 27-29

Claims amended: Claims 1-9, 11-16, 21-23, and 27-30

Claims withdrawn: Claims 1-9, 14-16, 21-23, and 30

3. Support for the Amendments

The claims are amended to recite *inter alia* a transesterified “composition.” The plain meaning of a composition is a mixture of compounds. Oils and fats are compositions, because they are mixtures of compounds. A triglyceride composition is a mixture of triglycerides. This meaning of “composition” is used throughout the specification. *See, e.g.*, page 20, line 24, through page 21, line 27; Example 2. The claims also are amended to replace “oil/fat” with “oil or fat.” Support for the amendment can be found throughout the specification. *See, e.g.*, page 20, line 24, through page 21, line 27.

Claim 1 is amended into independent form.

Finally, polyunsaturated fatty acids (PUFAs) containing “20 or more” carbons and “two or more” double bonds are amended to contain “20-24” carbons and “two to six” double bonds. The inherent properties of PUFAs, e.g., carbon length and double bond number, were well known to the skilled artisan at the time of filing. *See, e.g.*, http://en.wikipedia.org/wiki/Omega-3_fatty_acid (last updated October 3, 2010). *See also* page 14, lines 19-29 of the present disclosure. Accordingly, the amendments are not believed to add impermissible new matter.

4. Acknowledgement of Information Disclosure Statements

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements (IDS) submitted June 11, 2009, July 20, 2009, and December 7, 2009.

5. Request Regarding Vacated Notice of Non-Responsive Amendments

Applicants appreciate the Examiner’s August 13, 2010 communication, which vacates the Notice of Non-Responsive Amendment mailed August 6, 2010. PAIR, however, still reflects the entry of a Notice of Non-Responsive Amendment. The Office’s Patent Term Adjustment (PTA) audit will incorrectly record an Applicant delay under 35 U.S.C. § 154, unless the PAIR entry is corrected to reflect the fact that the Notice was vacated. Accordingly, Applicants request the PAIR entry dated August 6, 2010, as well as the two PAIR entries dated July 3, 2008, be changed to “Miscellaneous Communication.”

6. Withdrawn Rejections/Objections

Rejections and objections not repeated are withdrawn. *See* 37 C.F.R. § 1.113(b); MPEP §§ 706.07, 707.07(e).

7. Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 11-13 and 27-29 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Office alleges that the claims are vague and indefinite as to the position of the double bond in the compounds. The Office also alleges that the claims are vague and indefinite as to the expression “oil/fat or triglyceride” because the claim recites triglycerides.

Applicants traverse the rejections to the extent they apply to the amended claims. Applicants respectfully submit that the amended claims satisfy 35 U.S.C. § 112. The test for definiteness under 35 U.S.C. § 112 is whether the claims (in light of the specification) would apprise a person skilled in the art of the metes and bounds of the claims. Amended claim 11 recites *inter alia* “polyunsaturated fatty acids containing 20-24 carbons and two to six double bonds.” Thus, claim 11 and claims dependent thereon recite a clearly defined range of polyunsaturated fatty acids having 20-24 carbon atoms and two to six double bonds. Thus, person skilled in the art should be apprised of the metes and bounds of these recitations. Further, PUFAs are well known to contain up to 24 carbons and up to six double bonds. *See, e.g.*, http://en.wikipedia.org/wiki/Omega-3_fatty_acid (last updated October 3, 2010). Accordingly, the claims are definite, and the rejections should be withdrawn.

During the telephone Interview of February 25, 2011, the Office expressed concern that claim 11 may be indefinite because the claim does not specify the exact position of the double bonds in the polyunsaturated fatty acids. Thus, the Office asserts that claims reciting the polyunsaturated fatty acid may be broad and indefinite.

Applicants respectfully disagree. Even though the scope of the amended claims may be broad, the boundaries of the claim are clear and comply with 35 U.S.C. § 112. “Breath of a claim is not to be equated with indefiniteness.” *See* MPEP § 2173.04. Applicants respectfully submit that a person skill in the art reading the amended claims, e.g. claim 11, could immediately determine whether any polyunsaturated fatty acid falls inside or outside the scope of this claim by

counting the number of carbon atoms and the number of double bonds. Therefore, claim 11 and claims dependent thereon satisfy 35 U.S.C. 112.

Next, the Office alleges it is unclear whether the claims are directed to one or a mixture of compounds. The amendments clarify that the claims are directed to a composition, i.e., a mixture of compounds. For example, amended claim 11 recites *inter alia* “A transesterified composition containing at least 20% of polyunsaturated fatty acids” The Office also alleges it is unclear whether the claims are directed to oils, fat, triglycerides, or combinations thereof. The amendments clarify that the claims are directed to a composition.

Finally, the Office alleges that the absence of an upper range for the number of carbon atoms and the number of double bonds renders the claims too indefinite to search. As discussed in the Interview of February 25, 2011, Applicants respectfully submit that the amended claims recite *inter alia* upper limits on number of carbon atoms and the number of double bonds. Therefore, Applicants respectfully submit that a prior art search can and should be performed to place the application in condition for allowance.

Further, the Office *already* has searched the art and has cited art in the Non-Final Office Action of June 6, 2010. Further, Applicants have *already* distinguished the claims over the cited art in the Amendment and Response of December 7, 2009. The claims thus should be allowed in the next communication from the Office.

8. Rejections under 35 U.S.C. § 112, First Paragraph

Claims 11-13 and 27-29 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled by the specification. The Office alleges that some subject matter is enabled, but does not clearly state what the enabled subject matter is.

Applicants traverse the rejection to the extent the rejection is applied to the amended claims. The test for enablement is whether a person skilled in the art would have been able to make and use the claimed invention without resorting to undue experimentation. *See* MPEP § 2164.01. Claim 11 recites *inter alia* “polyunsaturated fatty acids containing 20-24 carbons and two to six double bonds.” Applicants respectfully submit that the specification does enable a person skilled in the art to make and use subject matter of claim 11, because the specification provides several specific examples of polyunsaturated fatty acids according to claim 11. *See, e.g.*

page 14, lines 19-29 of the present specification. Further, the inherent properties of PUFAs, *e.g.*, carbon length and double bond number, were well known to the skilled artisan at the time of filing. *See, e.g.*, http://en.wikipedia.org/wiki/Omega-3_fatty_acid (last updated October 3, 2010). The claims are amended to recite that the PUFAs contain 20-24 carbons and two to six double bonds. The Office has provided no evidence, as it must,¹ that the specification does not enable such PUFAs. For at least the above reasons, reconsideration and withdrawal of the rejection are respectfully requested.

9. Request for Interview in a Special Application

MPEP § 707.02 states that the Office must consider all applications up for third actions and/or applications pending five years as “special.” Both conditions apply to this application. Accordingly, the Supervisory Patent Examiner (SPE) should carefully review the next communication from the Office, and the Office should make “every effort” to terminate prosecution. *See* MPEP § 707.02. To assist the Office in terminating prosecution, Applicants request an interview with the Examiner and his SPE prior to the next Office communication.

¹ *In re Marzocchi*, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369 (C.C.P.A. 1971) (“[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.”).

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited. Applicants' representative is signing in his capacity under 37 C.F.R. §1.34 on behalf of Applicants.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayments to Deposit Account 50-0573. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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